

REMARKS

Claims 1 through 35 are currently pending in the application.

This amendment is in response to the final Office Action of October 3, 2005.

35 U.S.C. § 102(e) Anticipation Rejections

Anticipation Rejection Based on Grasso *et al.* (U.S. Patent Application Publication No. 2002/0116291 A1)

Claims 1-7 and 19-35 were rejected under 35 U.S.C. § 102(e) as being anticipated by Grasso *et al.* (U.S. Patent Application Publication No. 2002/0116291 A1).

Applicants assert that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Page 2 of the Office Action states that “[a]pplicant has failed to acknowledge element 210, figure 3 in Grasso (US 2002/0116291), that Examiner provided as being the ‘enterprise resource planning system’, and also failed to show how such element is different from the claimed ‘resource planning system’.” For the following reasons, Applicants assert that element 210 in Grasso is different than the recited enterprise resource planning system of the claimed inventions.

Applicants affirm that Grasso does not anticipate independent claims 1, 19 and 26 under 35 U.S.C. § 102 because each and every element of the claims is not expressly or inherently identically described in Grasso. More particularly, Grasso does not identically describe the element of the claimed inventions calling for data from an enterprise resource planning system as set forth in independent claims 1, 19 and 26.

Grasso describes a distributed knowledge management system 200 where a third party service provider 210 may process print jobs and transmit them to the user’s printer. (Grasso, FIG. 3; paragraphs [0024] and [0063], lines 1-13). For the process of printing on the local printer 112, the local user actually sends the print job to the system provider 210 and the local printer becomes a virtual printer when the system provider 210 creates a print queue for the print job in the service provider’s 210 *remote system server*. (Paragraph [0023]). The system provider 210 comprises a document processing service including recording the document 120

in a digital archive, extracting text, content indexing, and other services. (Paragraph [0058]). The user 50 may access the third party service provider 210 through the service provider's 210 webpage in order to browse and/or search the services offered by the service provider 210. (Paragraph [0059]).

Applicants respectfully assert that the service provider 210, as described in Grasso, is a third party that stores documents in a digital archive, extracts text and indexes content. The third party service provider also offers a web page, internet access, and a remote system server. However, there is no description, either inherently or expressly, that the third party service provider 210 is an enterprise resource planning system as alleged in the Office Action (Office Action, page 4).

As described in the Applicants' specification, enterprise resource planning (ERP) systems allow a company to manage, monitor and control data captured through isolated business activities. (Specification, paragraph [0027]). Common ERP systems include SAP R/3, Baan, and People soft. *Id.* ERP systems typically allow users to access and configure information generated in *any* segment of the business. *Id.* ERP systems rely on custom programmed Application Programming Interfaces, or ERP APIs to allow the ERP system to integrate with outside data sources. (Specification, paragraph [0028]).

To print, the ERP API communicates with the ERP system to retrieve and format the requested information and then transmit page description language commands that can be executed by the printer. (Specification, paragraph [0029]). However, information retrieved from the ERP system may be limited in its ability to be configured by the API. (Specification, [0031]). Many ERP systems do not provide thorough output management and distribution for the business documents and reports they generate, making it common for print jobs to be lost. (Specification, paragraph [0032]).

Moreover, problems associated with ERP APIs, print queues, print drivers, print job configuration and monitoring largely prevent ERP users from access to peripherals like printers outside of an ERP/LAN environment. (Specification, paragraph [0035]). As such, printing functions are limited between an ERP system environment and web-based services and devices.

Applicants assert that the web-based distributed knowledge management system 200 of Grasso relies on the Internet to provide user access to the service provider 210 and for the sending of print jobs to the user's printer. (Grasso, paragraph [0058]). Such a web-based

management system is incompatible with the limitations of current ERP systems. Moreover, Applicants assert that Grasso makes no indication that the service provider 210 is an ERP system or that any of the user printers are configured for ERP system access. Furthermore, Applicants assert that Grasso does not describe the services offered by the service provider 210 use an ERP API, or other form interface, to retrieve and format requested information. As such, Applicants assert that the service provider of 210 cannot be an ERP system as alleged in the Office Action. (Office Action, page 4).

Therefore, Applicants have shown that the service provider 210 is very different from the recited ERP system in the claimed inventions. As such, Applicants assert that Grasso fails to identically describe each and every element of rejected independent claims 1, 19 and 26 and those claims dependent therefrom. Applicants assert that such claims as well as the dependent claims therefrom are allowable.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Grasso in View of Croy (U.S. Patent Application Publication No. 2001/0047384 A1)

Claims 8 through 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Grasso in view of Croy (U.S. Patent Application Publication No. 2001/0047384 A1). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants assert that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, **the cited prior art reference must teach or suggest all of the claim limitations**. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

Independent claim 8 recites, in part, configuring data partially obtained from an ERP system. The Office Action proposes that Grasso and Coy teach all the limitations of claim 8. (Office Action, page 10). However, for the same reasons as set forth in the previous section, Applicants affirm that Grasso does not teach or suggest all of the limitations of claim 8.

Furthermore, Croy teaches systems and methods for presenting personalized audio content comprising, a client in communication with a server over a web-based network. (Croy, paragraph [0011]). As such, Croy's web-based system, like Grasso's, is incompatible with the ERP system recited in claim 8. Moreover, there is no indication that Croy's personalized audio provider system is an ERP system or involves an ERP system. As such, Croy's personalized audio provider system cannot be an ERP system. Accordingly, neither Grasso nor Croy, nor any combination thereof describes all the claim limitations of independent claim 8.

Additionally, because both Grasso's and Croy's web-based systems would be largely incompatible with an ERP system, Applicants assert that there would be no motivation to combine the cited reference and hope to successfully address the limitations of the ERP system as done by the claimed invention.

Therefore, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established regarding independent claim 8 and those claims dependent therefrom.

Accordingly, Applicants assert that claims 8-18 are allowable.

Applicants submit that claims 1 through 35 are clearly allowable over the cited prior art.

Applicants request entry of this response for the following reasons:

This response is timely filed.

This response does not require any additional search or consideration.

This response is believed to place the application in condition for allowance.

Serial No. 10/056,687

Applicants request the allowance of claims 1 through 35 and the case passed for issue. If, after consideration of the foregoing remarks, questions remain, the Office is asked to contact the applicants' undersigned attorney at the address or telephone number herein.

Respectfully submitted,



James R. Duzan
Registration No. 28,393
Attorney for Applicants
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: November 22, 2005
JRD/ps:lmh
Document in ProLaw